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In re Application of :
Brennan et al. :
Serial No.: 10/602,998 : PETITION DECISION
Filed: June 23, 2003 :
Attorney Docket No.: 28690-705.302 :

This is in response to the petition under 37 CFR § 1.181, filed May 25, 2006, requesting that the after final amendment filed on April 24, 2006 be entered into the above referenced application.

BACKGROUND

A review of the file history shows that the examiner mailed a non-final Office action to applicants on April 18, 2005, setting forth a three-month shortened statutory period for reply in which claim 14 was objected to as being an improper dependent claim. Claims 1, 14, and 15 were rejected under 35 USC 102(e) as being anticipated by Boles et al. The examiner also rejected claims 2-13 under 35 USC 103 as obvious over Rava et al. and Boles et al.

Applicants replied on August 12, 2005 and cancelled claim 14 and amended claims 1 and 2. Applicants also traversed both rejections made under 35 USC 102 (e) and 35 USC 103 wherein applicants indicated that the 102 (e) was overcome because of the submitted declarations and the 103 rejection was overcome because the references do not teach the claimed limitations.

In response to applicants' remarks, the examiner mailed a second non-final Office action on September 7, 2005 setting forth a three-month shortened statutory period for reply in which claims 1 and 15 were rejected under 35 USC 102 (b) as being anticipated by Monforte et al. Claims 2-13 were also rejected under 35 USC 103 as being unpatentable over Rava et al. and Monforte et al. taken together.

Applicants replied to this Office action on February 7, 2006 and amended the claims to recite that the primer is adapted to be released before, during or after the amplification reaction.

Applicants also argued that the primers of Monforte et al. can only be cleaved after amplification and, thus, Monforte et al. can neither be used in a 35 USC 102 or 35 USC 103 rejection.

The examiner mailed a final Office action to applicants on February 23, 2006, setting a three month shortened statutory period for reply. The examiner repeated the 35 U.S.C. 102 (b) rejection from the previous Office action. The examiner also repeated the 35 U.S.C. 103 rejection from the previous Office action.

On April 24, 2006, applicants requested reconsideration of the finality of the Office action of February 23, 2006 and amended the claims by deleting the claim language "during or after an" in reference to the amplification reaction.

On May 5, 2006, the examiner mailed an advisory action which stated that the amendment after final would not be entered as the proposed amendment raised new issues and did not simplify the issues for appeal.

In response thereto, applicants filed this petition on May 25, 2006 requesting that the amendment filed on April 24, 2006 be entered into the above referenced application.

DISCUSSION

Applicants' petition that the amendment after final be entered on the basis that the amendment which limits applicants primers to be released before an amplification reaction, was made pursuant to the examiners suggestion given in the final Office action and during the Interview to the effect that Monforte's primers differ from applicants' primers by their ability to be released after the amplification reaction. Applicants also disagree with the statement made by the examiner that their amendment raises new issues that require a further search because a complete search by the examiner would have included primers released before amplification. Finally, applicants argue the amendment narrows the scope of the claims and therefore does reduce the issues for appeal. Applicants' arguments are not persuasive since the remarks made by the examiner in the Interview Summary were not an invitation to amend the claims guaranteeing entry thereof. Also, applicants' claims alternatively set forth the requirement that the sequences be adapted to be released before, during or after. Thus, there was no requirement that the examiner find each adaptation during his search. Finally, the issues for appeal are not reduced at this time as a new search and consideration is necessary as the proposed amendment deletes "during or after" which significantly changes the scope of the claim.

DECISION

The petition is **DENIED**. Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in cursive script, appearing to read "George C. Elliott".

George Elliott
Director, Technology Center 1600